

rotating the patient from a substantially supine position to a substantially prone position;  
and

alternately laterally rotating the patient about a longitudinal axis of the bed across an arc spanning from between positive 15 to 62 degrees from the prone position to a negative 15 to 62 degrees from the prone position.

### REMARKS

#### *Support for claim of priority*

The present application (hereinafter referred to as the '739 application) is a national stage application of PCT application PCT/IE99/00049. Its filing date is the filing date of the PCT application, or June 3, 1999.

As of June 3, 1999, there was an earlier filed co-pending United States application disclosing part of the invention. The earlier filed application was U.S. Patent Application Ser. No. 09/099,397 (hereinafter referred to as the '397 application), which was based on PCT/IE96/00087, which correspondingly was based on Ireland patent application 950950, filed Dec. 19, 1995. The '397 application matured into U.S. Patent No. 6,112,349 on September 5, 2000.

While the '739 application did not originally claim priority to the '397 application, it did incorporate its subject matter by reference. See page 14, lines 24-26.

Pursuant to 35 U.S.C. § 120, an application for patent of an invention disclosed in a previously-filed co-pending United States application "shall have the same effect, as to such invention, as though filed on the date of the prior invention" if each of the three following conditions are met:

- the prior filed application names as an inventor at least one inventor named in the later-filed application;
- the later-filed application is filed before the patenting or abandonment of or termination of proceedings on the first application; *and*
- it contains or is amended to contain within “such time during the pendency of the application as required by the Director” to contain a specific reference to the earlier filed application.

This application meets all three conditions. First, the late Patrick Joseph Connolly was the lead inventor of both the ‘739 and ‘397 applications. Second, the ‘739 application was filed before the ‘397 application matured into a patent. Third, as explained below, this preliminary amendment is being made within “such time during the pendency of the application as required by the Director.”

37 C.F.R. § 1.78 provides the conditions for claiming the benefit of an earlier filing date. Subsection (a)(2)(ii) provides the default rule: “If the later-filed application is a non-provisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application.” If this default rule applied, the latest date would be four months from December 4, 2000, or April 4, 2001. Under this default rule, it would be too late without a petition to accept an unintentionally delayed claim.

But the default rule does not apply here. Subsection (a)(2)(ii) provides that “[t]he time periods in this paragraph do not apply if the later filed application is . . . (C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.” Accordingly, it is not the date when the application entered the national stage (i.e., December 4, 2000) that

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counts. Rather, it is the date the international application was filed under 35 U.S.C. 363 (i.e., June 3, 1999) that counts. June 3, 1999, is before November 29, 2000. Therefore, the time periods of subsection (a)(2)(ii) do not apply.<sup>1</sup>

Acceptance of the priority-claiming amendment is respectfully requested.

*Support for new language in summary of invention*

Support for the added language in the “summary of the invention” section is provided in WO 97/22323, which was already incorporated by reference. *See* page 14, lines 24-26. Rather than referring to WO 97/22323, reference will be made to the column and line numbers of issued U.S. Patent No. 6,112,349 (“the ‘349 patent”), as they have the same specification.

Please note that the language added to the “summary of the invention” is simply a distillation of the newly added claims. Therefore, the incorporated matter that provides support for the newly added claims necessarily also provides support for the amendments to the “summary of the invention.” The page and line numbers of the supporting portions of the ‘349 patent are identified below, in connection with the newly added claims.

In light of the incorporation by reference, it is respectfully submitted that these amendments add no new matter.

*Support for amendments to existing claims*

Many elements of the original claims were expressed, in accordance with 35 U.S.C. § 112, as a “means . . . for performing a specified function without the recital of structure, material, or acts in support thereof.” To avoid unnecessarily strict constructions that could potentially be given to “means plus function” elements, the assignee is amending some of these elements to claim specific structure. Other preliminary amendments are made for the purpose of eliminating limitations that are believed to unduly restrict the scope of the claimed invention.

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<sup>1</sup> *See also* 66 FED. REG. 67087, 67088-67089 (December 28, 2001) (explaining amendments to section (a)(2)).

Claim 1 is amended to substitute “motor operable to rotate” for “drive means for rotating.” Column 6, lines 40-43 of the ‘349 patent supports this amendment.

Claim 1 is also amended to substitute a “guide body” for the previously recited “guide means” language. Page 5, lines 1-36 of the ‘739 application supports the amendments in this paragraph.

Claim 2 is amended to substitute “the guide body is mounted on the patient support platform” for “means is provided for securing the patient care lines on the guide means.” Page 16, lines 11-16 of the ‘739 application supports this amendment.

Claims 3, 5, and 21 are canceled, not for reasons of patentability, but to reduce the cost of the claims newly added here.

Claim 4 is amended to substitute structural for functional recitals – namely, to substitute “guide body” from the “guide means” and to distinguish the “bore” from the “guide body.” It will be understood that under the pre-amended version of the claim, the “guide means” covered both the “bore” and the “guide body.”

Claim 6 is amended to make it consistent with the changes to claim 1.

Claim 7 is amended to substitute structural for functional recitals. Page 5, lines 25-29 of the ‘739 application supports this amendment.

Claim 8 is cancelled because it is superfluous with claim 7, as amended.

Claim 9 is amended to eliminate reference to “closure means” and to refer only to the structure itself.

Claim 10 is amended to eliminate the limitation to “vertical movement.”

Claims 12, 13, 17, 19, and 20 are amended to substitute structural recitals for some of the functional recitals.

Claim 14 is amended to pluralize the word "pair."

*Support for the newly added claims*

Column 5, lines 66-67, column 6, lines 35-39, and column 7, lines 34-50, of the '349 patent support the subject matter of newly added claim 23.

Column 2, lines 21-57 and the abstract of the '349 patent support the subject matter of newly added claims 24-35.

Column 2, line 65 through column 3, line 36 support the subject matter of newly added claims 36-39.

Column 2, lines 9-33, Column 5, lines 54-65, Column 6, line 60- Column 7, line 29, and the Abstract support the subject matter of newly added claims 40-43.

Column 2, lines 27-31, 58-64 of the '349 patent support the subject matter of newly added claims 44-49.

Col. 5, lines 51-57, and col. 7, lines 9-11, of the '349 patent support the subject matter of newly added claims 50-54.

Col. 6, lines 7-21 of the '349 patent support the subject matter of newly added claims 55-58.

Col. 1, lines 19-25, col. 6, lines 54-67, and col. 7, lines 1-8 support the subject matter of newly added claims 59 and 60.

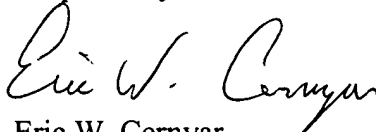
In light of the aforementioned support, it is respectfully submitted that the newly added claims add no new matter. Also, in light of the amendment of the specification, it is respectfully submitted that adequate section 112 support is provided for the newly added claims.

## CONCLUSION

The Applicant is seeking the signed declarations of Una Connolly the executrix of inventor Patrick Connolly's estate, as well as that of co-inventor Mr. Vijayendran. Those declarations, if and when obtained, will be submitted in a supplement to this preliminary amendment. In addition, the Applicant is in the process of obtaining a certified copy of Ireland application 950950.

The undersigned respectfully asks that the amendments be considered and accepted, that the claims be allowed, and that the application be passed to issuance as a patent. The Commissioner is authorized to deduct any fees that may be required from Kinetic Concepts' deposit account #500-326.

Respectfully submitted,



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